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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/483,248 01/14/00 TSEUNG

K LABV.P0002

HM22/0913

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EXAMINER

CHAUDHRY, M

ART UNIT

PAPER NUMBER

1623

/8

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/483,248

Applicant(s)

TSEUNG ET AL.

Examiner

Mahreen Chaudhry

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group II, claims 11-16 and 23-27 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the inventions of groups II and III could be classified together and that patentable distinctness was not established. This is not found persuasive because group II is directed to an apparatus for staining slide specimens comprising a control means for reading identifiers and group III is directed to a slide rack and a reagent pack. Each of these inventions are separately classifiable in class 435, subclass 286.1 and class 435 subclass 287.1, respectively. Furthermore, a reference disclosing a slide rack containing receptacles for a slide and a reagent pack would not render obvious an apparatus for automatic staining comprising a control system for reading identifiers on specimen slides.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claim 11 is objected to because of the following informalities: in claim 11, there is a typographical error in line 14 of the claim; in claim 16, there is a typographical error in line 3 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is unclear with regard to the phrase "at lease one slide tray, said slide tray for holding at least one specimen slide and an associated reagent pack." It is unclear whether the slide tray holds the reagent pack in addition to the specimen slide or if the slide tray holds only the specimen slide and is associated with a reagent pack.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by each of U.S. Patent 5,439,649 issued to Tseung et al. and U.S. Patent 5,595,707 issued to Copeland et al. Tseung et al. disclose an automatic staining apparatus comprising a microscope slide holder for holding microscope slides and an associated reagent container holder (Column 2, Lines 36-64; Column 17, Lines 19-35). Tseung et al. disclose that reagent from the reagent containers is dispensed onto microscope slides for staining (Column 2, Lines 58-64; Column 5, Lines 14-26).

Copeland et al. disclose an automated biological processing apparatus comprising a slide support carousel with a plurality of slide supports and a reagent carousel with a plurality of

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reagent container supports (Column 2, Lines 42-65; Column 19, Lines 58-61). Copeland et al. further disclose that the apparatus comprises a reagent delivery actuator which delivers reagent from reagent containers to slides on the slide support (Column 2, Lines 42-65).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,439,649 issued to Tseung et al. in view of U.S. Patent 5,948,359 issued to Karla et al. Tseung et al. disclose a programmable automatic staining device. Tseung et al. disclose that the staining device comprises a reagent container holder, a microscope slide holder and control means for controlling the staining arm and that reagent from the reagent container is picked up and dispensed over the microscope slides (Column 2, Lines 36-64). Tseung et al. further disclose that the apparatus may also scan bar codes on microscope slides and reagent containers so that different staining protocols can be practiced (Column 16, Lines 38-51). Tseung et al. additionally disclose that multiple slides may be placed in removable trays including a loading tray in which staining operations will be conducted (Column 12, Lines 37-41). Tseung et al. teach that the apparatus is operated under the control of a computer so that the operation protocol may be varied and the user may select appropriate motions from menus (Column 14, Lines 45-57). Tseung et al. further teach that the user may select which slides to be treated and the length

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of treatment time (Column 14, Lines 57-66). Tseung et al. additionally teach that the apparatus may include drain trays with exit lines to waste reservoirs (Column 16, Lines 23-30).

Tseung et al. do not expressly teach that the staining apparatus has multiple reagent packs as well as pause and restart inputs. Kalra et al. disclose an automatic staining device with a framework for holding multiple reagent vials, a microscope slide holder and a control means such as a computer to apply appropriate reagent to the slides in the slide tray (Column 5, Lines 31-43; Column 6, Lines 46-59). Kalra et al. disclose that the apparatus may include drain bins with exit conduits to waste reservoirs (Column 19, Lines 56-59). Kalra et al. further disclose that the apparatus may be operated in either the open format which permits greater user input or the closed format requiring little user input using bar codes on the reagent vials and microscope slides (Column 7, Lines 54+). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included a multiple reagent vial holder in the apparatus taught by Tseung et al. comprising a microscope slide holder and a computer control means for reading bar codes on the slides and reagent container since both Tseung et al. and Kalra et al. teach similar automatic staining devices with slide holders, computer control means, a movable arm and reagent container holders. It would additionally have been obvious to one having ordinary skill in the art to have included control formats in the apparatus which permit conventional user input such as pausing and restarting since both Tseung et al. and Kalra et al. teach that the automatic control means permit user input. Neither Tseung et al. or Kalra et al. expressly disclose an apparatus comprising a tiltable sink assembly with two drain holes. However, it would therefore have been obvious to one having ordinary skill in the art to have included drain bins with exit conduits to appropriate waste reservoirs since both Tseung et al.

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and Kalra et al. teach that drain bins with exit conduits to waste reservoirs may be included in the apparatus.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,650,327 issued to Copeland et al. discloses an automatic immunostaining apparatus with multiple slide supports, multiple reagent supports and a control means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahreen Chaudhry whose telephone number is (703) 605-1200. The examiner can normally be reached on Monday – Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701 . The official fax phone number for the organization where this application is proceeding or assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

mc
September 5, 2001



GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1600